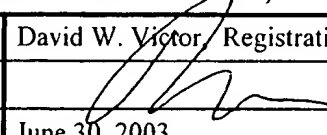


TRANSMITTAL FORM	Application Number	09/388,261
<i>(To be used for all correspondence after initial filing)</i>	Filing Date	August 31, 1999
	Inventor	J.M. Nagda et al.
	Group Art Unit	2177
	Examiner Name	Mohammad Ali
Total Number of Pages in this Submission:	Attorney Docket Number	BLD919990027US1


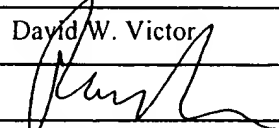
ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits /Declarations <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement; ___ references <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an application) <input type="checkbox"/> Drawing(s); ___ sheets <input type="checkbox"/> Licensing-related papers <input type="checkbox"/> Petition: _____ <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation, and/or Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) ___	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (<i>Appeal Notice, Brief, Reply Brief</i>) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Certificate of Correction <input type="checkbox"/> Other Enclosure(s) (<i>please identify below</i>)
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual Name:	David W. Victor, Registration No. 39,867
Signature:	
Date:	June 30, 2003
KONRAD RAYNES VICTOR & MANN, LLP 315 South Beverly Drive, Suite 210 Beverly Hills, California 90212 (310) 556-7983	
<input checked="" type="checkbox"/> The Commissioner is authorized to charge any deficiency of fees, or credit any overpayment, to Deposit Account No. 09-0457	

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S.N. 09/388,261 Docket No. BLD919990027US1 Date Mailed 6/30/03 By: DWV/pm

Title: A WORKFLOW MANAGEMENT SYSTEM FOR GENERATING OUTPUT
MATERIAL BASED ON CUSTOMER INPUT

Client: International Business Machines Corporation

0036.0042

Receipt is hereby acknowledged for the following received in the Patent & Trademark Office,
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

#20

Applicant:	J.M. Nagda et al.	Examiner:	Ali, M.
Serial No.:	09/388,261	Group Art Unit:	2177
Filed:	August 31, 1999	Docket No.:	BO999027
TITLE:	A WORKFLOW MANAGEMENT SYSTEM FOR GENERATING OUTPUT MATERIAL BASED ON CUSTOMER INPUT		

CERTIFICATE UNDER 37 CFR 1.8:

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David W. Victor

REPLY TO EXAMINER ANSWER

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Pursuant to 37 CFR 1.193, Applicants submit a Reply to the Examiner's Answer in the above appeal dated April 29, 2003 ("Answer").

In the Answer, the Examiner repeated on pages 3-5 the rejection set forth in the Final Office Action dated March 18, 2002 ("Final Office Action"), which Applicants traversed in the Appeal Brief.

1. Reply To Examiner's Answer With Respect to the Claims in Group I (Claims 1, 2, 4-7, 11, 12, 13, 15-18, 22, 23, 25-28)

In responding to Applicant's argument as to why the portions of Dedrick cited in the Final Office Action do not teach or suggest the claim requirement of accessing at least one content file by querying a second database table using values in one received customer record in a first database table, and then generating the content of each accessed file in the received output

material, the Examiner cited col. 8, lines 27-31 of Dedrick. (Answer, pgs. 6-7) Applicants note that the Examiner did not cite to col. 8 of Dedrick when rejecting these claims in the previous Final Office Action.

The cited col. 8 discusses an appraisal agent that can search yellow page servers to locate electronic content that matches the end user's profile data, which may indicate information, such as advertisements, that the user wants to view. (Dedrick, col. 8, lines 20-30) The appraisal agent accesses the user profile data to use for a search criteria for electronic advertisements the user wants to view. Once located, the advertisement is returned to the end user. Id., col. 8, lines 37-47).

Although the cited Dedrick discusses using user profile information to search for advertisements from yellow page servers, nowhere does the cited Dedrick anywhere teach or suggest the claim requirement that each content file accessed by querying a second database table using values in a customer record is generated into output material. Instead, Dedrick mentions returning advertisements or the title of advertisements (col. 8, line 64 to col. 9, line 24), but nowhere teaches or suggests the claim requirement of generating content of each accessed content file, accessed by querying a second database, into the output material.

On page 7 of the Answer, the Examiner mentions the "Sherman teaching", but nowhere cites to any Sherman reference, nor was a "Sherman" reference mentioned in the rejection of claims 1, 11, and 21.

In the Answer, the Examiner maintains the position that the cited col. 9, lines 7-15 and FIG. 15 of Tackbary teaches the claim requirement of transmitting the output material via a selected delivery option. (Answer, pg. 7) The cited col. 9 of Tackbary mentions a mail box mode to allow a user to electronically select a method by which a card is sent. Applicants continue to traverse the finding that Tackbary teaches the claim requirement of transmitting the output material because nowhere does the cited Tackbary nor Dedrick teach the claim requirements of storing the delivery option in a customer record whose values are used to query a database to access the content for the output material. The Examiner does not cite any art that

suggests such a claimed combination and, thus, is proposing modifications to the cited prior art that are nowhere taught or suggested in the cited art.

The Examiner further argues that it is appropriate to combine the references. (Answer, pg. 8). However, even if one modifies Dedrick with Tackbary as the Examiner proposes, the proposed modification still only teaches that a user may select a delivery method. Nowhere does the proposed modification of Tackbary anywhere teach or suggest that the delivery option be stored in a customer record whose values are used to query a database to access the content for the output material. Thus, the proposed modification still fails to teach the combined claim requirements.

Accordingly, Applicants request the Board to reverse the Examiner's decision with respect to claims 1, 12, and 22 because the Examiner has failed to cite art in the Answer that teaches or suggests the claim requirements discussed above.

Applicants further request the Board to reverse the Examiner's decision with respect to claims 2-11, 13-21, and 23-32 in Group I because these claims depend from claims 1, 12, and 22, which are patentable over the cited art for the reasons discussed above.

2. Reply To Examiner's Answer With Respect to the Claims in Group II (Claims 3, 14, and 24)

Claims 3, 14, and 24 depend from claims 1, 12, and 22 and further require that generating the customer records comprises executing a mining program against a database including customer information to determine information to populate at least one customer record from the customer.

In responding in the Answer to Applicants arguments that the cited col. 1, line 37 to col. 2, line 15 of Dedrick does not teach or suggest the additional requirements of claim 3, 14, and 24, the Examiner cited new sections of Dedrick, including col. 5, lines 54-59 and col. 6, lines 58-59, as teaching these claim requirements. (Answer, pg. 9) Applicants traverse the findings that these additional sections of Dedrick cited in the Answer teach the additional requirements of claims 3, 14, and 24.

The cited col. 5 mentions that the personal profile database may also include additional information for a user, such as credit card numbers, social security numbers, mailing addresses, etc. Nowhere does the cited col. 5 anywhere teach or suggest that when generating the customer records, a mining program is executed against a database including customer information to determine information to populate the customer record.

The cited col. 6 mentions that information from monitoring the user activity can be added to the personal profile database for a user, such as information on a piece of electronic information made available to the end user for consumption. Nowhere does this cited section anywhere teach or suggest the use of a mining program to determine information to populate a customer record as claimed.

Nowhere do the newly cited cols. 1 and 2 of Dedrick anywhere suggest how to get customer information to add to a customer record as claimed using a mining program, which is stored in the first database.

Accordingly, Applicants submit that the Examiner has failed to cite art in his Answer that teaches or suggests the requirements of claims 3, 14, and 24.

3. Reply To Examiner's Answer With Respect to the Claims in Group III (Claims 8, 19, and 29)

Claims 8, 19, and 29 in Group III are patentable over the cited art because they depend from claims 1, 12, and 22, which are patentable over the cited art for the reasons discussed above. Moreover, the claims in Group III are separately patentable over the cited art for the reasons discussed below.

Claims 8, 19, and 29 depend from claims 1, 12, and 22 and further require processing a template including queries of records in the second database table. These claims require that accessing at least one file using values in one received customer record comprises accessing at least one value in a field in one customer record to include in a query against the second database table and applying the query against the second database to determine a record associated with a file including fields matching the query. The accessed file is associated with the determined

record. In such case, generating the content into the output material comprises generating the content into the template, which forms the output material.

In refuting Applicants arguments of patentability in the Answer, the Examiner cites to col. 14, lines 60-62 of Dedrick. (Answer, pg. 10) The cited col. 14 mentions that an interactive process may allow the end user to answer queries and take alternate paths to external data. Nowhere does the cited col. 14 anywhere teach or remotely suggest the claim requirements of a template including queries of records in a second database table and accessing a value in one customer record to include in the query against the second database table.

Accordingly, Applicants submit that the Examiner has failed to cite art in his Answer that teaches or suggests the requirements of claims 8, 19, and 29.

4. Reply To Examiner's Answer With Respect to the Claims in Group IV (Claims 9, 20, and 30)

Claims 9, 20, and 30 in Group IV are patentable over the cited art because they depend from claims 1, 12, and 22, which are patentable over the cited art for the reasons discussed above. Moreover, the claims in Group IV are separately patentable over the cited art for the reasons discussed below.

Claims 9, 20, and 30 depend from claims 8, 19, and 29 and further require that there are multiple files for each query, wherein the records associated with the files for each query have different values in at least one field, and wherein determining the record comprises determining the record from the files associated with the query that matches the search criteria.

The Examiner cited col. 14, lines 60-62 of Dedrick and FIGs. 3-5 in refuting Applicants' arguments of patentability in the Appeal Brief. (Answer, pg. 11). The cited col. 14 mentions that an interactive process may allow the end user to answer queries and take alternate paths to external data. Nowhere does the cited col. 14 anywhere teach or suggest multiple content files for each query, wherein the records associated with the files have different values, such that one of the records whose values match the query is determined.

Accordingly, Applicants submit that the Examiner has failed to cite art in his Answer that teaches or suggests the above discussed requirements of claims 9, 20, and 30.

5. Reply To Examiner's Answer With Respect to the Claims in Group V (Claims 10, 21, and 31)

Claims 10, 21, and 31 in Group V are patentable over the cited art because they depend from claims 1, 12, and 22, which are patentable over the cited art for the reasons discussed above. Moreover, the claims in Group V are separately patentable over the cited art for the reasons discussed below.

Claims 10, 21, and 31 depend from claims 9, 20, and 30 and further require that each query is maintained in a container in the template, wherein the file having the associated record that matches the query is generated into the container, further comprising resizing the appearance of the file content generated into the containers in the output material.

In the Answer, the Examiner cited col. 3, line 50 of Dedrick to refute the Applicant's arguments in the Appeal Brief. (Answer, pg. 11) The cited col. 3 mentions consumer variables providing information on a user profile. Nowhere does the cited col. 3 anywhere teach or suggest the claim requirement that each query is maintained in a container in the template and resizing the appearance of the file content generated into the containers in the output material.

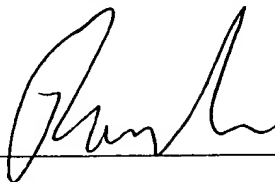
Accordingly, Applicants submit that the Examiner has failed to cite art in his Answer that teaches or suggests the requirements of claims 10, 21, and 31.

Conclusion

The rejections of claims 1-32 in the Final Office Action is improper and should be reversed.

Dated: June 30, 2003

By: _____



David W. Victor
Reg. No.: 39,867

Please direct all correspondences to:
David Victor
Konrad Raynes Victor & Mann, LLP
315 South Beverly Drive, Ste. 210
Beverly Hills, CA 90212
Tel: 310-553-7977
Fax: 310-556-7984